

28. (Unamended) The composition according to claim 1 formulated as a hair shampoo, a body cleanser or a hand cleanser.

29. (Unamended) The composition according to claim 2 formulated as a hair shampoo, a body cleaner or a hand cleanser.

Add the following new claim 30:

30. (New) The composition according to claim 2 wherein said low density oily material is a difatty ester selected from the group consisting of Jojoba oil, oleyl oleate, oleyl erucate and mixtures, thereof.

REMARKS

After entering the instant amendment, claims 1-3 and 5-30 are pending in the present application, claim 4 having been cancelled and its subject matter incorporated into amended claim 2. Claim 30 is new. Claims 1-2, 8, 10-12, 14-15 and 26 have been amended to address the Examiner's rejections. All the other remaining claims are either unamended (claims 3, 5-7, 9, 13, 16-25 and 27-29) or are new (claim 30). Applicants believe that the amendment to the claims now obviates the Examiner's rejections of the instant application, which is in condition for allowance. Support for the amendments to the claims can be found throughout the original specification and claims. Support for new claim 30 can be found in the specification on page 11 and in original claim 10.

The Examiner has rejected original claims 1-29 variously under 35 U.S.C. §§112, second paragraph, 102 and 103. For the reasons which are set forth in detail hereinbelow, Applicants respectfully submit that the application as presented is now in condition for allowance.

The §112 Rejection

The Examiner has rejected claims 10-12, 14-15 and 26 under 35 U.S.C. §112, second paragraph as being rendered vague and indefinite for the reasons which are stated in the office action in paragraph 2 on page 2. In order to address the Examiner's concerns the claims have

been amended. For example, in the case of claims 11 and 12, Applicants have amended those claims to reflect the fact that both alkyl carboxylic acid salts and alkylether carboxylic acid salts are claimed. In the case of claims 14 and 15, the term "comprises" is now correctly used in those claims. Further, claim 26 has been amended to correct the term "andr" and the fact that the claimed monoesters are "obtained from fatty esters and fatty alcohols, said monoesters containing a total of from 36 to 42 total carbons."

With the entry of the proposed amendments, it is respectfully submitted that the claims now render the claims concise and definite and in conformance with 35 U.S.C. §112.

The §102 Rejection

The Examiner has rejected originally filed claims 1-2, 4-5, 8-14, 16-21, 24-26 and 28-29 under 35 U.S.C. §102(b) as being anticipated by Fowler, U.S. patent no. 5,635,469 ("Fowler"). It is the Examiner's view that Fowler essentially inherently teaches the presently claimed compositions for the reasons which are stated in paragraph 5 of the office action. Applicants respectfully traverse the Examiner's rejection.

The present invention relates to certain compositions which are multiple phase surfactant compositions comprising at least two distinct and separate liquid phases upon settling, wherein the compositions comprise a first or lower high density emollient/conditioning layer comprising at least one high density aromatic ester emollient or conditioning agent having a specific gravity of greater than 1.00 and at least one additional layer comprising a surfactant solution having a specific gravity which is less than the specific gravity of the high density layer. The present invention is directed to compositions which exhibit activity as surfactant compositions having emollient characteristics and a pleasant two-layered presentation. Thus, the present invention relates to compositions which exhibit excellent surfactant and emollient/conditioning characteristics with a superior presentation. Contrary to the Examiner's contention, Fowler does not anticipate the present invention, either literally or inherently.

Fowler teaches foaming cleansing products which can contain, inter alia, surfactants as well as emollients/conditioners. However, Fowler does not disclose compositions which are in two layers. Fowler clearly does not specifically or literally disclose such compositions and contrary to the Examiner's contention, there is no inherent disclosure of the present invention.

With respect to the Examiner's argument that Fowler inherently anticipates the present invention, it is respectfully submitted that the Examiner has not made out a cogent case that the present invention is inherent in the compositions of Fowler.

The Doctrine of Inherency Relied Upon by the Examiner

In order to find a claimed invention invalid under the doctrine of inherency, the Examiner must show that one of ordinary skill following the teachings of the reference must necessarily, inevitably and always produce every element of the claimed invention. Mere possibilities, probabilities or accidents are not sufficient for making out a proper case under the doctrine of inherency. The result must be *absolutely certain*. See In re Robertson, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999); Glaxo, Inc. v. Novopharm, Ltd., 52 F.3d 1043, 34 U.S.P.Q.2d 1565 (Fed. Cir. 1995), *cert. denied*, 116 S.Ct. 516 (1995); Electro Medical Systems, S.A. v. Cooper Life System, Inc., 34 F.3d 1048, 32 U.S.P.Q.2d (Fed. Cir. 1994); Continental Can Co. USA v. Monsanto Co., 948 F.2d 1264, 1269, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991); W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553-54, 220 U.S.P.Q. 303, 313-14 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); In re Oelrich, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 325-26 (C.C.P.A. 1981); and Phillips Petroleum Co. v. U.S. Steel Corp., 673 F.Supp. 1278, 1295 n.12, 6 U.S.P.Q.2d 1065, 1076-77 n.12 (D.Del. 1987), among others. It is respectfully submitted that the Examiner has asserted a legal doctrine which has been misapplied to the facts of the instant invention. There is simply no possible way that the Examiner's inherency argument may be cogently maintained in the face of the teachings of Fowler and the claims of the present invention.

The Examiner cannot cite any specific composition which is disclosed in Fowler which meets the limitations of the claimed invention. Rather, the Examiner relies on generic

disclosures in Fowler (see paragraph 5 of the January 28, 2003 office action) to argue that one of ordinary skill will essentially “cherry pick” the correct components as claimed in the present application in order to produce a composition as claimed, which is desirably characterized by exhibiting at least two distinct and separate liquid phases. While it is true that one of ordinary skill might be able to pick the proper components of the present invention out of the large number of embodiments which are disclosed in Fowler, it is respectfully submitted that that possibility only occurs as a consequence of the person of ordinary skill having been shown the present invention. Without the teachings of the present invention, the likelihood that one of ordinary skill will reliably and consistently produce the present invention does not exist.

It is noted that the Examiner cannot cite a single, specifically disclosed composition of Fowler which *necessarily, always and inevitably* meets the limitations of the claims of the present invention. Because the Examiner cannot cite any composition which meets the requirements of the doctrine of inherency as established by relevant caselaw, the Examiner has failed to make out a cogent case that the present invention is unpatentable. The mere possibility that one of ordinary skill might *accidentally* produce the present invention using the components generically disclosed in Fowler does not obviate the deficiencies of the rejection based upon inherency. As such, the present invention is clearly novel over the cited art.

Nowhere in Fowler is there a disclosure or even an oblique mention of different phases, phase separation, layering, differential phase coloration or component specific gravities, i.e., densities. In short, there is nothing in Fowler which even remotely suggests that Fowler provided a composition or a teaching which gives rise to the present invention. It is respectfully submitted that the Examiner has failed to make out a case that the present invention is inherently anticipated by the present invention.

The §103 Rejection

The Examiner has rejected originally filed claims 3, 7, 8-9 and 22-23 variously under 35 U.S.C. §103. Applicants shall address each of these rejections in the following paragraphs.

The Rejection of Claims 3, 7 and 27 Based upon Fowler and Meiwa

The Examiner has rejected originally filed claimed 3, 7 and 27 based upon the disclosure of Fowler (see above) and Meiwa, et al., U.S. patent no. 6,294,509 ("Meiwa"). The Examiner cites Fowler and Meiwa for their putative teachings as set forth in paragraph 8 of the January, 2003 office action. In particular, the Examiner cites Fowler for teachings a number of components which may be used in the present invention, namely components a-d as set forth in paragraph 8.

The Examiner cites Meiwa for disclosing an exfoliating agent and in particular, polyethylene particles for inclusion in detergent cosmetic compositions. Based upon the combined disclosures of Fowler and Meiwa, it is the Examiner's position that claims 3, 7 and 27 are invalid as being obvious over a combination of the teachings of these references for the reasons stated in the office action at paragraph 8. Applicants respectfully traverse the Examiner's rejection.

The description of the present invention, set forth above, is referenced here. Applicants claim a surfactant composition having favorable characteristics of emolliency and/or conditioning characteristics, which is further characterized by the composition having at least two distinct and separate liquid phases. Despite the contentions of the Examiner, a combination of Fowler and Meiwa do not in any way disclose or suggest the present invention.

As discussed hereinabove, Fowler clearly does not disclose or suggest multiphasic surfactant compositions as are presently claimed. Indeed, Fowler is absolutely silent on this aspect. Moreover, it is respectfully submitted that a multiphasic surfactant composition is *counterintuitive* to the teachings of Fowler, who wishes to combine his composition with a *foam dispenser*. It is respectfully submitted that using a multiphasic surfactant composition with the foam dispenser of Fowler is actually counterintuitive and counterproductive to the invention set forth in Fowler. As discussed hereinabove, Fowler clearly does not disclose or suggest multiphasic surfactant compositions as are presently claimed. Indeed, Fowler is absolutely silent on this aspect. Moreover, it is respectfully submitted that a multiphasic surfactant composition is

counterintuitive to the teachings of Fowler, who wishes to combine his composition with a *foam dispenser*. It is respectfully submitted that using a multiphasic surfactant composition with the foam dispenser of Fowler is actually counterintuitive and counterproductive to the invention set forth in Fowler. To provide a multiphasic composition of the present invention to the Fowler foam dispenser would result in the composition *not working*, because the whole purpose of the foam dispenser is to maintain a consistent *single phase* composition to be delivered mechanically. Consequently, it is respectfully submitted that Fowler actually teaches away from the present invention.

Turning to Meiwa, this reference clearly does not obviate the stark deficiencies of Fowler. While Meiwa does disclose the use of polyethylene particles for use as exfoliants in detergent cosmetic compositions, it is respectfully submitted that this reference does not disclose or even remotely suggest the desirability of a multiphasic *liquid* presentation of the composition. Indeed, Meiwa is absolutely silent as to this important feature of the present invention.

Combining Fowler and Meiwa does not in any way disclose or suggest the present invention. Given the absence of any discussion or oblique suggestion of the desirability of a multiphase liquid composition as claimed, the present invention is clearly patentable over Fowler and Meiwa.

The Rejection of Claims 8-9 and 22-23 Based upon Fowler and Walele

The Examiner has rejected originally filed claimed 8-9 and 22-23 based upon the disclosure of Fowler (see above) and Walele, et al., U.S. patent no. 5,959,130 ("Walele"). The Examiner cites Fowler and Walele for their putative teachings as set forth in paragraph 9 of the January, 2003 office action. In particular, the Examiner cites Fowler for teachings a number of components which may be used in the present invention, namely components a-d as set forth in paragraph 8.

The Examiner cites Walele for teaching the inclusion of the aromatic ester emollient composition dipropylene glycoldibenzoate in cosmetic compositions. From this, and the

teachings of Fowler, the Examiner concludes that the present invention is unpatentable under 35 U.S.C. §103. Applicants respectfully traverse the Examiner's rejection.

The multiphasic liquid compositions according to the present invention as claimed are referenced here. In contrast to the Examiner's characterization, the present invention is patentable over the teachings of Fowler and Walele.

As discussed hereinabove, Fowler clearly does not disclose or suggest multiphasic surfactant compositions as are presently claimed. Fowler is absolutely silent on this aspect. Moreover, as discussed above, it is respectfully submitted and cogently argued that the teachings of Fowler are at best *inapposite* to the present invention and are more favorably characterized as *teaching away* from the present invention, inasmuch as the mechanical nature of Fowler's delivery system *necessitates* a consistent single phase. This is not the present invention and in no way even obliquely brings to mind the present invention.

Walele does not cure the deficiencies of Fowler. Walele is directed generally to castor based benzoate esters. Walele only mentions the aromatic ester emollient *dipropylene glycoldibenzoate* in the generic description of the invention. However, the teachings of Walele does not in any way even obliquely disclose or suggest the multiphasic liquid compositions of the present invention. It is respectfully submitted that combining a reference, Fowler, which at best, is *inapposite* to the present invention, and is more favorably characterized as *teaching away* from the present invention, with a reference Walele, which is not even relevant to the present invention other than to disclose a single aromatic ester emollient which can be used in the present invention does not make out a cogent case that the present invention is unpatentable. Indeed, the absence of relevance of the cited art *dictates* that the present invention is patentable.

For all of the above reasons, it is respectfully submitted that the present application is now in condition for allowance and such action is earnestly solicited. 1 dependent claim (claim 4) has been cancelled and 1 dependent claim (claim 30) has been added to the present application. No fee is therefore due for the presentation of this amendment. A petition for a two month extension of time is enclosed as is a check for \$205. If the Examiner decides that any

additional fee is required, or that any credit is due, the Commissioner is authorized to charge any such fee or credit any such overpayment to deposit account 04-0838.

An indication of any charge made to the authorized Deposit Account is respectfully requested at the time of the issuance of a further office action, so that the charge may be accurately tracked.

Dated: 6/9/03

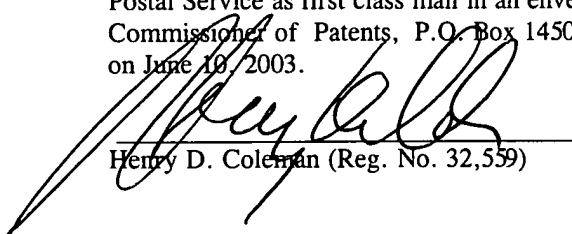
Respectfully submitted,
Coleman Sudol Sapone, P.C.

By: 

Henry D. Coleman
Reg. No. 32,559
714 Colorado Avenue
Bridgeport, Connecticut 06605-1601
(203) 366-3560

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to:
Commissioner of Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450,
on June 10, 2003.


Henry D. Coleman (Reg. No. 32,559)